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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,772	08/04/2003	Elinor Isobel Forbes	MS-02/3/US	5121

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James C. Forbes
101 Pointe Drive, #403
Northbrook, IL 60062

EXAMINER	
MUSSELMAN, TIMOTHY A	

ART UNIT	PAPER NUMBER
3714	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/633,772	FORBES ET AL.	
	Examiner	Art Unit	
	Timothy Musselman	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 November 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

In response to the communication dated 11/13/2007, claims 21-38 are pending in this application. Claims 1-20 have been cancelled.

Claim Rejections - 35 USC § 103

The following is a quotation of the relevant portion of 35 U.S.C. 103 that forms the basis for the rejections made in this section of the office action;

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Claims 21, 26, and 32-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Everett (US 6,398,222) in view of Cohen et al. (US 3,726,027).

Regarding claims 21, 26, and 32-38, applicant has claimed a method comprising precisely two steps. The first method step is to provide a kit to an adult subject with dementia, and the second step is to encourage the subject to assemble the kit. The remainder of claim 21 pertains to structural limitations of the kit for assembly.

Providing kits for adult sufferers of dementia for assembly is old and well known in the art. See Everett, col. 2: 18-48, wherein Everett discloses the need for providing games to a subject with dementia for therapy (enjoyment and stimulation are consistent with applicant's definition of therapy from pages 5-6 of

the specification). Everett further discloses wherein the provided game is a kit is for assembly. See col. 5: 29-43.

In light of Everett's establishment that both steps of applicant's method are old and well known in the art, it is the position of the office that the substitution of alternative kits known in the art would have been obvious to one of ordinary skill in the art at the time of the invention whether or not those kits were designed for the purpose of therapy for dementia sufferers. This is so because Everett has already established applicant's method steps of providing kits for use by dementia subjects, and further because none of applicant's structural limitations are novel. Rather, applicant's structural limitations are merely a combination of elements known in the art of assembly kits and puzzle/game type devices, and thus the combination of these various structural limitations combined broadly with the disclosure by Everett that it is known to provide kits to subjects with dementia would merely be a combination of elements known in the art, and no unexpected results would ensue, as the established result of such activities at the time of applicant's invention was already well known to be therapeutic value. As further evidence consider the disclosure by Dondero (US 5,538,432) that it is old and well known to provide Dementia subjects with pastimes involving the distinguishing of colors, shapes, and textures for stimulation (i.e. therapy). See col. 1: 29-44. With the aforementioned reasons for obviousness in mind, the structural elements of applicant's invention will now be addressed broadly.

Everett discloses placing pieces on a rack wherein they resist accidental disarrangement. See col. 5: 29-36. This is also the limitation of claims 26.

Everett discloses wherein the pieces have multiple sides. See fig. 1B labels 7 and 8. Everett does not teach wherein the pieces are covered in various soft fabrics of differing tactility (individually and on different sides of a single piece). However, Cohen discloses that this concept is old and well known in the art of assembly kits. See col. 3: 53-62 and col. 4: 11-25, and note that the pieces can be flannel or fur

(claims 32-28). It would have been obvious to include this feature in the therapeutic method of Everett because it would merely be using known characteristics of kits in a known method of presenting kits to dementia subjects for therapy.

Claims 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Everett (US 6,938,222) in view of Cohen et al. (US 3,726,027) and in view Ostrar et al. (US 5,738,559).

Regarding claims 22-25, applicant is claiming a fabric patchwork kit. This type of kit is old and well known in the art. For example, Ostrar discloses just such a kit. See col. 2: 1-45, wherein the creation of a patchwork hand puppet is disclosed, that involves the combination of at least two fabric elements together by use of lacing (without needles for safety and ease). It would have been obvious to include this kit in the therapeutic method of Everett because it would merely be using a known type of kit in a known method of presenting such kits to dementia subjects for therapy.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Everett (US 6,938,222) in view of Cohen et al. (US 3,726,027) and in view of Lockhart et al. (US Des. 277,492).

Regarding claim 27, applicant is claiming a standard jigsaw type puzzle (similar to fig. 6 of applicants spec). This type of kit is old and well known in the art, as shown for example in the design patent to Lockhart et al. in fig. 1, which shows a puzzle comprising multiple pieces which reside inside a single aperture in a tray when completed properly. It would have been obvious to include this kit in the therapeutic method of Everett because it would merely be using a known type of kit in a known method of presenting kits to dementia subjects for therapy.

Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Everett (US 6,938,222) in view of Cohen et al. (US 3,726,027) and in view of Studen (US 3,280,499).

Regarding claims 28 and 29, applicant is claiming the use of a kit comprising apertures specifically sized to fit specific pieces. This type of puzzle is old and well known in the art, and can be seen in Studen, fig. 2. It would have been obvious to include this kit in the therapeutic method of Everett because it would merely be using a known type of kit in a known method of presenting kits to dementia subjects for therapy.

Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Everett (US 6,938,222) in view of Cohen et al. (US 3,726,027) and in view of Kemnitzer (US 3,849,912) and Ostrar (US 5,738,559).

Regarding claims 30 and 31, applicant is claiming the use of a kit comprising a pegboard for placing fabric patches with multiple eyelets. Kemnitzer discloses a kit for placing objects comprising multiple eyelets onto a pegboard. See fig. 1. However, there is no teaching wherein the pieces are fabric. Yet, fabric pieces for assembly kits are old and well known in the art. Recall the reference to Ostrar that utilized the fabric pieces of the puppet kit, as described in col. 2: 1-45. It would have been obvious to include these kit features from Kemnitzer and Ostrar in the therapeutic method of Everett, because it would merely be using known kits and variations thereof in a known method of presenting kits to dementia subjects for therapy.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21, 26, 27-28, 30, 33-35, and 37-38 are rejected on the grounds of nonstatutory double patenting over claims 1-2, 5, and 7 of U. S. Patent No. 6,626,678, since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent. The subject matter of the specified claims in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: All of the limitations of instant claims 21, 26, and 38 are found in claim 1 of the '678 patent. All of the limitations of instant claims 27 and 28 are found in claim 5 of the '678 patent. All of the imitations of instant claim 30 are found in claim 7 of the '678 patent. All of the limitations of instant claims 33-35 and 37 are found in claim 2 of the '678 patent.

Response to Arguments

Applicant's arguments dated 11/13/2007 have been fully considered but are moot in view of the new grounds of rejection. Examiner concurs that applicant appears to be owed $65, but regretfully is not in a

position to correct or even address this issue in any way. It is possible that assistance with this matter may be found by calling (571)272-1000.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy Musselman whose telephone number is (571)272-1814. The examiner can normally be reached on Mon-Thu 6:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571)272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TM

TM

Ronald Laneau
Primary Examiner
Art Unit 3714

1/23/08